

REMARKS / ARGUMENTS

Remaining Claims

Seventeen (17) claims (Claims 1 – 8 and 10 – 18) remain pending in this application through this Amendment.

Rejection of Claims 1 – 5, 8, and 10 – 17 under 35 USC §102(e) - Tsuzuki, et al.

Claims 1 – 5, 8, and 10 – 17 stand rejected under 35 USC §102(e) as anticipated by US Patent No. 6,417,144 to *Tsuzuki, et al.*.

Tsuzuki, et al. has a US filing date of June 13, 2001. The present application claims priority of 60/253,757, filed November 29, 2000. Applicants, therefore, respectfully request that this rejection be withdrawn, as *Tsuzuki, et al.* is not properly cited as §102(e) art.

Examiner responded in the instant Office Action that *Tsuzuki, et al.* has an effective filing date of June 14, 2000. Applicant respectfully submits that this is incorrect. The relevant portion of §102 reads, in part:

A person shall be entitled to a patent unless —***

(e) the invention was described in — *** (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language;

Tsuzuki, et al. claims benefit of a Japanese application under §119(a)-(d) and is not an international application as defined in §351(a). In fact, the MPEP offers pertinent guidance in §706.02(f)(1), Example 3:

No benefit of the filing date of the foreign application is given under 35 U.S.C. 102(e) for prior art purposes (*In re Hilmer*, 149 USPQ 480 (CCPA 1966)). Thus, a publication and patent of a 35 U.S.C. 111(a) application, which claims benefit under 35 U.S.C. 119(a)-(d) to a prior foreign-filed application (or under 35 U.S.C. 365(a) to an international application), would be accorded its U.S. filing date as its prior art date under 35 U.S.C. 102(e). (MPEP Rev. 2, May 2004; Page 700-30).

Thus, no benefit of the filing date of the Japanese application is given for the purposes of §102(e) prior art. Accordingly, the prior art date of *Tsuzuki, et al.* for §102(e) is the US filing date – June 13, 2001. Because this is after the effective filing date of the present application, *Tsuzuki, et al.* is not properly cited as prior art. Accordingly, Applicants respectfully request that this rejection be withdrawn.

Rejection of Claims 6, 7, and 18 under 35 USC §103(a) - Tsuzuki, et al.

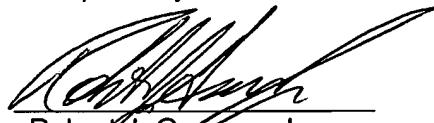
Claims 6, 7, and 18 stand rejected under 35 USC §103(a) as being obvious under US Patent No. 6,417,144 to *Tsuzuki, et al.* as applied above.

As discussed above, because *Tsuzuki, et al.* is not properly cited as §102(e) art, Applicants respectfully request that this rejection be withdrawn.

CONCLUSION

In view of the foregoing and in conclusion, Applicants submit that the 35 USC §§102 and 103 rejections set-forth in the Office Action have been overcome, and that the pending claims are not indefinite, anticipated by, or obvious over the cited art, either individually or in combination. Applicants request reconsideration and withdrawal of the rejection(s) set-forth in the Office Action. Should the Examiner believe that a discussion with Applicants' representative would further the prosecution of this application, the Examiner is respectfully invited to contact the undersigned.

Respectfully submitted,



Robert J. Gorman, Jr.
Reg. No. 41,789
(678) 415.4389

CIBA Vision Corporation
11460 Johns Creek Parkway
Duluth, GA 30097

g:\busunits\legal\public\patents\prosecut\31594\response c.doc